

REMARKS

The Office Action of May 15, 2007 has been carefully studied. The fee for the three-month extension of time is attended to. The following paragraphs correspond to the order of the paragraphs of the Office Action:

Election/Restriction

The finality of the restriction requirement is acknowledged.

Information Disclosure Statement

Applicants do not understand the statement in the Office Action regarding listing of references in the specification since a conventional Information Disclosure Statement was filed with the application, a copy of same being attached herewith along with the receipt card from the Patent Office which indicates that the Information Disclosure Statement was filed with the application. The International Branch should have forwarded the cited references to the Examiner since one of the purposes of the PCT was to facilitate the submission of references in all elected countries. Nevertheless, if the Examiner has not received the references from the International Branch, attached are the following references for the Examiner's consideration. It is respectfully submitted that a fee is not required for this submission to the Examiner of references that should already be in the file.

1. U.S. 6,120,987, issued September 19, 2000 - Daniel Aspe.
2. DE 3642939 A1, published December 10, 1987 - Daniel Aspe.
3. Abstract of DE 3642939.
3. Goodchild J: "Conjugates Of Oligonucleotides And Modified Oligonucleotides: A Review Of Their Synthesis And Properties" Bioconjugate Chemistry, American Chemical Society, Washington, US, Vol. 1, No. 3, 1 May 1990, pages 165-187.
4. WO 98/26287, published June 18, 1998 - Daniel Aspe.

Specification

The trademark Bodipy is now explained on page 1 of the specification as designating a class of substituted 4,4-5fluoro-bora-3A, 4Adiaza-s-indacene compounds. These compounds are well known as seen from the patent literature, for example WO 97/000967 (page 12 in particular) and as well as U.S. 4,774,339.

Claim Objections and Claim Rejections Under 35 U.S.C. § 112

It is seen that original claims 1-41 are cancelled and a new set of claims 42-64 are added. These new claims avoid the objections set forth in the Office Action in numbered paragraphs 4-10. Support for new claim 42 is based on original claims 1, 6 and 26 as well as the specification on page 7, lines 29-31 and page 21, lines 10-26 and the working examples.

With respect to the dependent claims, they are based on original claims 2-5, 14-25, 27 and 30.

Claim Rejections - 35 U.S.C. § 102

Neither claim 26 nor claim 29 were rejected over Glazer et al. U.S. 5,853,992, and since new claim 42 incorporates said claims, it is not anticipated.

With respect to Tyagi et al. (U.S. 5,925,517), claim 6 was not rejected over this patent and therefore new claim 42 which incorporates claim 6 is not anticipated.

Claim Rejections - 35 U.S.C. § 103

Bearing in mind that aggregation is a serious problem in this art, as discussed in Applicants' specification, the fact that Applicants provide novel conjugates which exhibit virtually zero aggregation of the fluorophore could possibly have been discerned from the combination of cited references. As stated in the recent KSR v. Teleflex Supreme Court decision, there must be a rational reason, in the absence of Applicants' disclosure for one of ordinary skill to combine teachings of references much less in this highly complex art. In addition, Applicants' claimed conjugates are useful as acceptor fluorescent compounds or donor

fluorescent compounds in the presence of donor fluorescent compounds or acceptor fluorescent compounds which provides an additional unexpected benefit to Applicants' invention.

Finally, for the sake of good order, Applicants wish to point out that sequence A15 is explained in Applicants' specification on page 31 where the process for obtaining this sequence is clearly described. In other words, sequence A15 is a sequence having 15 nucleic acid A.

In view of the submission of the newly amended claims and the above remarks, favorable reconsideration is courteously requested.

If there are any residual issues which can be expeditiously resolved by a telephone conference, the Examiner is courteously invited to telephone Counsel at the number indicated below.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,

/I. William Millen/

I. William Millen, Reg. No. 19,544
Attorney/Agent for Applicant(s)

MILLEN, WHITE, ZELANO
& BRANIGAN, P.C.
Arlington Courthouse Plaza 1, Suite 1400
2200 Clarendon Boulevard
Arlington, Virginia 22201
Telephone: (703) 243-6333
Facsimile: (703) 243-6410

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